

### **REMARKS**

After entry of the present Amendment, claims 1-3, 5, 6, and 8-15 and 17 remain pending in the subject application. Claim 1 is currently amended to incorporate component (D), which is a non-crosslinkable oil, and specifies that component (D) contains component (A) and is dispersed in water in the form of droplets. Support for currently amended claim 1 can be found at least in original claim 4, as well as paragraph [0025] of the subject application as published (specifically, U.S. Publ. Pat. Appln. No. 2006/0127338). Claim 5 is currently amended merely to correct claim dependency in view of the fact claim 4 is cancelled in the present Amendment, i.e., claim 5 now properly depends from claim 1. As such, no new matter is introduced via the present Amendment. Claims 4, 7 and 16 are cancelled in the present Amendment. No claims are added or withdrawn.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,928,660 to Kobayashi et al. (the '660 patent) in view of U.S. Pat. No. 5,496,959 to Day (the '959 patent), as evidenced by Webster's Ninth New Collegiate Dictionary and information regarding siloxane polymerization available on the Dow Corning website (i.e., [http://www.dowcorning.com/content/sitech/sitechbasics/siloxane\\_polymerization.asp](http://www.dowcorning.com/content/sitech/sitechbasics/siloxane_polymerization.asp)).

The Examiner contends that the '660 patent discloses a raw material for cosmetic use comprising an aqueous suspension of a powdered silicone rubber having a mean particle size of 0.5 to 50 microns. The Examiner also contends that the '660 patent discloses use of one or more surfactants, though the Examiner expressly admits that the '660 patent fails to disclose the surfactants expressly claimed in the subject application. Finally, the Examiner

contends that the '660 patent discloses that its aqueous suspension of a silicone rubber contains a non-crosslinked oil. However, in view of Applicants' amendment of independent claim 1, as well as the reasons set forth below, the Examiner's rejection is respectfully overcome.

In particular, the Examiner contends that the '660 patent discloses that its "suspension also contains non-cross-linked oil specifically being added in the silicon rubber particles . . ." (see page 5 of the Final Office Action). The Examiner goes on to state that this "addresses the limitation of the aqueous emulsions of cross-linked silicone particles as recited in instant claim 4." This is not correct.

Original claim 4, the subject matter of which is incorporated in currently amended claim 1 in the present Amendment, expressly recited that component (A) is contained in droplets of component (D) dispersed in water. This is further clarified in currently amended claim 1, which states "component (D) contains component (A) and is dispersed in water in the form of droplets." Thus, as clearly set forth in currently amended claim 1, component (A) has an average particle size of from 0.5 to 500 $\mu$ m, and the particles of component (A) are dispersed in the droplets of component (D) in water.

Conversely, the '660 patent fails to teach, disclose, or even suggest silicone rubber particles dispersed in a non-crosslinked oil, as suggested by the Examiner. Rather, the '660 patent discloses "an aqueous suspension of a powdered silicone rubber containing a non-cross-linked oil." (See column 3, lines 8-10 of the '660 patent). Clearly, in the '660 patent, it is the powdered silicone rubber itself which contains the non-cross-linked oil. This is

further evidenced in column 3, lines 21 and 22 of the '660 patent, which states that the "oil is caused to impregnate the powdered silicone rubber . . ." The '660 patent also states that "[t]he abovementioned non-cross-linked oil is an oil which is simply contained in the abovementioned powdered silicone rubber . . ." (See column 3 lines 24-26 of the '660 patent). As such, in the '660 patent, the powdered silicone rubber itself is impregnated with the non-cross-linked oil. Conversely, in view of Applicants' amendment of independent claim 1, the subject application expressly claims a non-crosslinkable oil containing cross-linked silicone particles. Notably, the Examiner's secondary references do nothing to cure this deficiency of the '660 patent.

The Examiner has improperly overlooked this distinction between the disclosure of the '660 patent and the claims of the subject application, especially in view of the fact this feature of the claimed invention was previously claimed in original claim 4. Because Applicants' amendment does not introduce new matter, and does not present new issues requiring further consideration or search (in view of the fact this feature was claimed in original claim 4), the Applicants respectfully request entry of the present After Final Amendment. See MPEP § 714.13.

Notwithstanding the above, not only does the '660 patent fail to disclose, teach, or even suggest a suspension in which a non-crosslinkable oil contains cross-linked silicone particles in any way whatsoever, but the '660 patent teaches away from such a suspension. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would

be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994). As the Examiner is aware, “[a] prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness.” MPEP § 2141.02. A teaching away of the claimed invention is a significant factor in determining obviousness even in view of *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727 (2007). More specifically, the Court in *KSR* stated that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *Id.* at 1740 (*citing United States v. Adams*, 383 U.S. 39, 51-52 (1966)). In particular, column 4, lines 56-63 of the ‘660 patent states:

It is desirable that the content of the abovementioned non-cross-linked oil in the powdered silicone rubber be 80 wt % or less, and a content of 50 wt % or less is especially desirable. The reason for this is that it is difficult to prepare a powdered silicone rubber whose non-cross-linked oil content exceeds the abovementioned limit, and there is a danger that cosmetics obtained using such a powdered silicone rubber will be sticky. (emphasis added).

Thus, the ‘660 patent clearly teaches the difficulty of preparing a powdered silicone rubber with content of non-cross-linked oil of greater than 50 wt %. Moreover, the ‘660 patent expressly teaches that if the amount of non-cross-linked oil is such that the powdered silicone rubber is not impregnated with the total non-cross-linked oil, there is a danger that the cosmetics obtained therefrom will be sticky, which is undesirable. As such, one of skill in the art, upon a full reading of the ‘660 patent, would have no reason whatsoever to modify the powdered silicone rubber of the ‘660 patent such that the powdered silicone rubber is no longer impregnated with a non-cross-linkable oil, but suspended within a droplet of non-

crosslinkable oil. This is particularly true in view of the '660 patent's expressly teaching with respect to the deleterious effect of such a modification. This is an unambiguous teaching away of the presently claimed invention.

Finally, though no longer necessary in view of Applicants' amendment of independent claim 1, the Applicants once again assert the results obtained via the subject invention are unexpected, as set forth in Applicants' previous response. Interestingly, the Examiner contends that Applicants' data "is purely subjective and not substantiated with sound scientific data." (see, *inter alia*, page 11 of the Final Office Action). This conclusory statement by the Examiner has absolutely no support or basis in fact. The Examiner has failed to explain how an objective comparison of physical properties is "purely subjective," or how such an objective comparison "is not substantiated with sound scientific data."

The Examiner is respectfully reminded that "[e]vidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut prima facie obviousness. Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a prima facie case of obviousness. No set number of examples of superiority is required." (emphasis added) MPEP § 716.02(a) (*citing In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)).

The Examiner repetitively states that "Applicants did not really compare any of [the compositions of the '660 patent] to their compositions." (see page 11 of the Final Office Action). However, based on Applicants' amendment of independent claim 1, which clearly

distinguishes the Applicants' invention from the invention of the '660, patent, this comparison is no longer necessary. Notwithstanding that fact, the Applicants once again assert unexpected results of the claimed invention relative to the prior art, as described in greater detail immediately below.

As expressly admitted by the Examiner, the '660 patent fails to disclose the instantly claimed surfactants, and merely states that a surfactant may be utilized. As such, Applicants' comparative data, which illustrates the superiority of Applicants' claimed surfactants relative to other common surfactants, in fact does compare the Applicants' claimed composition to the compositions of the '660 patent, contrary to the Examiner's assertion. In addition, the Examiner contends that the compositions of the '660 patent include other ingredients in addition to the surfactants, so Applicants' comparative data is not representative of the compositions of the '660 patent. However, Applicants respectfully remind the Examiner that "Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner." (emphasis added) MPEP § 716.02(e) (*citing In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961)). As such, the fact that the compositions of the '660 patent may contain additional ingredients not included in the claimed composition is wholly irrelevant when the Applicants' comparative data is more closely related to the claimed invention than the compositions disclosed in the '660 patent, i.e., the Applicants' comparative data does not include the ingredients of the compositions of the '660 patent that are not utilized in the subject invention. Thus, the Applicants once

again submit that the claimed invention possesses unexpected results relative to the compositions disclosed in the '660 patent, notwithstanding the express teaching away of the instantly claimed invention present in the '660 patent described above.

In view of the foregoing, the Applicants respectfully submit that claims 1-3, 5, 6, and 8-15 and 17 are both novel and non-obvious over the prior art including over the '660 patent and the '959 patent, either individually or in combination. As such, the Applicants submit that the claims are in condition for allowance and respectfully request such allowance. As set forth above, because Applicants' amendment merely incorporates previously claimed subject matter, the Applicants respectfully request entry of the present After Final Amendment.

This response is timely filed; thus, it is believed that no further fees are presently due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,  
**HOWARD & HOWARD ATTORNEYS, PLLC**

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